



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,606	08/02/2001	Mats Dahlback	19378.0011	6441

7590 08/12/2003

Swidler Berlin Shereff Friedman
Suite 300
3000 K Street N W
Washington, DC 20007

EXAMINER

WILKINS III, HARRY D

ART UNIT	PAPER NUMBER
----------	--------------

1742

14

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/857,606

Applicant(s)

DAHLBACK ET AL.

Examiner

Harry D Wilkins, III

Art Unit

1742

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 24 July 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 13-15 and 17-26.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Continuation of 2. NOTE: the issue that the alloy has a substantially uniform composition throughout was not considered in the finally rejected claims, and, thus, would require further search and/or consideration.

Continuation of 5. does NOT place the application in condition for allowance because: regarding Mardon et al, though Mardon et al teach an alloy that is used in a duplex cladding tube, the requirement that the alloy be a cladding tube and that the cladding tube be made totally of the claimed alloy do not appear in the claims. In fact, the claims include such duplex cladding tubes, particularly in claims 22 and 25. The only requirement of the claims is a cladding tube comprising the alloy, thus leaving the whole of the cladding tube open to include multiple layers of differing compositions. Though Mardon et al teach adjacent ranges with coinciding end points for the ranges of Sn and Nb, such disclosures have been held to be anticipatory in nature. See MPEP 2131.03. Regarding Nomoto et al, Anada et al and Isobe et al, an overlapping range (such as the overlapping range of Nb taught by Nomoto et al) have been held to be anticipatory in nature, and thus supported in an obviousness rejection without motivation. See MPEP 2131.03. With respect to the broad ranges disclosed by Nomoto et al, Anada et al and Isobe et al, it has been held that when the prior art discloses broad ranges and the prior art provides for the functions of those elements, a prima facie case of obviousness has been established. See MPEP 2144.05. II. Such a case of obviousness can be overcome by a showing of unexpected results within the narrow claimed range(s). However, Applicant's assertion in the specification of unexpected results does not prove that the results exist. Conclusory statements are not probative unless supported by facts. See Ex Parte Gray 10 USPQ 2d 1922 (BPAI 1989); In re deBlauwe 222 USPQ 191, 196 (Fed. Cir. 1984); In re D'Ancicco 172 USPQ 241 (CCPA 1972); In re Grunwell 203 USPQ 1055 (CCPA 1979); Meitzner v. Mindick 193 USPQ 17; In re Brandstandter 179 USPQ 286, 294 (CCPA 1973); In re Lindner 173 USPQ 356; and In re Smith 74 USPQ 207. In the present case, Applicant's have not shown through use of comparison data that the presently claimed invention produces the asserted unexpected results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry Wilkins, III whose telephone number is (703) 305-9927. The examiner can normally be reached on Monday-Thursday 10:00 am -8:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application of proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

August 5, 2003
hdw

Harry D. Wilkins, III
Examiner
Art Unit 1742


ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700